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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/676,692  | 10/01/2003  | Timothy J. Hebrink   | 53550US016          | 8156             |
| 32692   | 7590        | 09/22/2004           | EXAMINER            |                  |
| 3M INNOVATIVE PROPERTIES COMPANY<br>PO BOX 33427<br>ST. PAUL, MN 55133-3427 |             |                      | CHEN, VIVIAN        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1773                |                  |

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/676,692 | Applicant(s)<br>HEBRINK ET AL. |  |
|                              | Examiner<br>Vivian Chen       | Art Unit<br>1773               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-49 of U.S. Patent No. 6,352,761 (HEBRINK ET AL); or

(b) claims 1-27 of U.S. Patent No. 6,641,900 (HEBRINK ET AL); or

(c) claims 1-32 of U.S. Patent No. 6,111,697 (MERRILL ET AL);

in view of WO 95/17303 (hereinafter WO '303).

The above HEBRINK ET AL and MERRILL ET AL patents each claim a multilayer optical film wherein the optical film comprises of plurality of birefringent first layers comprising a first copolyester and a plurality of isotropic (i.e., little or no birefringence) second layers comprising a second copolyester, wherein the first

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copolyester comprises naphthalate subunits and wherein the second copolyester comprises carboxylate subunits such as naphthalate and/or terephthalate, glycol subunits derived from C2-C4 diols, and a variety of comonomer subunits such as those derived from t-butyl isophthalic acid and cyclohexane dicarboxylic acid; and compounds having three or more carboxylate or hydroxy functionalities such as trimethylol propane, said various subunits being present in the amounts recited in the application claims. The first and second layers have substantially similar refractive index values in one in-plane direction. (US '761, especially claims 1, 7-9, 14, 16-19, 24, 33-49) (US '900, especially claims 14-27) (US '697, especially claims 1-14, 29-32). The features not explicitly claimed in the above patents are obvious or well known in the prior art.

WO 95/17303 discloses known optical stack designs and material selections typically used to make high efficiency optical film structures and devices. The reference further discloses various comonomers used in polyester resins in order to obtain specific optical (i.e., refractive indices, birefringence or lack thereof) such as alkane diols, etc. (entire document, especially pages 28-30)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate known comonomers into copolyesters and use the resulting copolyesters as the first and second copolyesters in an optical film in order to obtain the specific optical characteristics (e.g., reflectance, transmission, polarization, refractive indices, birefringence or lack thereof, etc.) required for specific applications.

***Conclusion***


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 20, 2004

  
Vivian Chen  
Primary Examiner  
Art Unit 1773